

REMARKS

After entry of this preliminary amendment, claims 25-62 will be pending. The final Office Action dated April 23, 2003 rejected previously pending claims 1-5, 7, 8, 13 and 15 under 35 U.S.C. 102(b) as being anticipated by Taenzer (U.S. Patent No. 5,751,820, hereafter Taenzer). Previously pending claims 9-12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Taenzer in view of Topholm (U.S. Patent No. 5,202,927) or Kerns (U.S. Patent No. 6,144,748) or Anderson (U.S. Patent No. 5,721,783). Previously pending claims 16-24 were rejected under 35 U.S.C. 103(a) as being unpatentable over Taenzer in view of Kerns (U.S. Patent No. 6,144,748) or Anderson (U.S. Patent No. 5,721,783).

Taenzer was cited for teaching a hearing aid that can wirelessly communicate with a remote processor, the remote processor communicating with a cellular communication system. The Office Action also noted that the hearing aid of Taenzer could perform in a first mode equivalent to a hearing aid mode. Topholm was cited for teaching a memory for storing processing parameters. Kerns was cited for teaching a memory, digital processing means and other features relevant to controlling operation as well as a hearing aid device in which external devices can be connected through an input/output port. Anderson was cited for teaching a processor with a memory structure as well as a hearing aid apparatus in which an external communication device can be connected to a remote processor using an input/output port for receiving audio signals.

In new claims 25-62, the claimed hearing aid includes an internal processor. The hearing aid can operate in two different modes of operation, either as a hearing aid or in conjunction with an external communications device. As a hearing aid, the signals from the microphone are processed by the internal processor and output through the speaker. If the hearing aid is used in conjunction with an external communications device, at least the speaker of the hearing aid is coupled to the external communications device.

Applicants note that Taenzer teaches a device (i.e., device **10**) that resides within the user's ear or in close proximity to the user's ear that contains a transceiver. The primary transmitter and receiver (i.e., transmitter **12** and receiver **13**) reside in close proximity to the user (e.g., on the user's waist, within a telephone, within a computer). (Col. 4, line 57 – col. 5, line

10) When the device is used as a hearing aid, the signals received by the earpiece must first be digitized, formatted and transmitted as packets via downlink signal 11B to receiver 13 using reflective technology. Receiver 13 extracts the information and processes it prior to reassembling the processed information into packets to be sent via uplink signal 11A by transmitter 12 to transceiver 11. (Col. 6, lines 8-22). In marked contrast to the complicated processing system taught by Taenzer, the present invention processes signals from the microphone using an internal processor. Thus the steps of digitizing, formatting, transmitting packets of information via a downlink signal, extracting information, reassembling processed information, formatting, transmitting the packets of information via an uplink signal, etc. are eliminated in the present invention. Neither Taenzer nor the other cited references suggest a hearing aid as presently claimed that can either process sounds using an internal processor to address specific hearing impairments or operate in conjunction with a remotely located communications device.

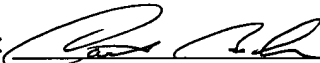
Applicants submit that the current claims are not obvious in view of the cited art. In particular Applicants note that the courts have held that in order to avoid a hindsight-based obviousness analysis there must be a clear showing of the teaching or motivation to combine the prior art references. See, for example, *C.R. Bard, Inc. v. M3 Sys., Inc.*, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) (describing “teaching or suggestion or motivation [to combine] as an “essential evidentiary component of an obviousness holding”); or *In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (evidence of teaching or suggestion “essential” to avoid hindsight).

In the present situation Applicants submit that there is no clear evidence of a teaching, suggestion or motivation to include internal processing in the device disclosed by Taenzer. Furthermore there is no evidence to suggest that an internal processor could even be used in the disclosed Taenzer apparatus.

Accordingly, in view of the above remarks and newly submitted claims, it is submitted that this application is now ready for allowance and early notice to this effect is solicited.

If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned at (415) 789-9144.

DATE: 7/25/03 Respectfully submitted,

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